

## REMARKS

### **A. Summary:**

The subject application sets forth claims 1-9, 13 and 15-16, with claim 1 being the sole independent claim.

Claims 1-6 and 13-16 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,193,815 (Pollard) in view of U.S. Patent No. 4,756,535 (Hopkins et al.). Claims 7-9 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Pollard in view of Hopkins et al. and further in view of U.S. Patent No. 4,778,153 (Bachman).

Applicants respectfully traverse each of the above rejections and request reconsideration based on the present amendments and following remarks.

### **B. Rejection of Claims 1-6 and 13-16 (35 U.S.C. § 103(a))**

Claims 1-6 and 13-16 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,193,815 (Pollard) in view of U.S. Patent No. 4,756,535 (Hopkins et al.). For the reasons set forth below, Applicants respectfully submit that certain structural limitations set forth in claim 1 are not disclosed in Pollard or in Hopkins et al., and so the obviousness rejection should be withdrawn. The present amendments to claim 1 are submitted to more clearly highlight those structural limitations that clearly distinguish the subject lottery ticket game over the cited prior art.

Claim 1 is directed to a lottery ticket, and includes several readily-identifiable physical components, including a first play area and a second play area comprising a plurality of second play regions, as well as an imprinted identification system of first and second indicia. The first play area comprises a plurality of first jig-saw type puzzle pieces imprinted therein, wherein each puzzle piece has specifically defined structural characteristics. In particular, each first jig-saw type puzzle piece has an irregular shape and at least one first irregular shaped mating surface comprising a projection or cavity adapted to mate to a complimentary mating surface comprising a projection or cavity of at least one other first jig-saw type puzzle piece. The first jig-saw type puzzle pieces

are covered by a removable scratch-off layer.

An example of the physical structure set forth above is shown in Figure 2 of the subject application (copied below). In the illustrated lottery ticket, first jig-saw type puzzle pieces 14 in a first play area 6 (on the right-hand side of Fig. 2's lottery ticket) respectively include at least one mating surface. The mating surfaces correspond to either a projection (such as projection 18 in puzzle piece bearing indicia 4A) or a cavity (such as cavity 20 in puzzle piece bearing indicia 2B). These aspects are more particularly described in the original specification at page 5, lines 1-5.

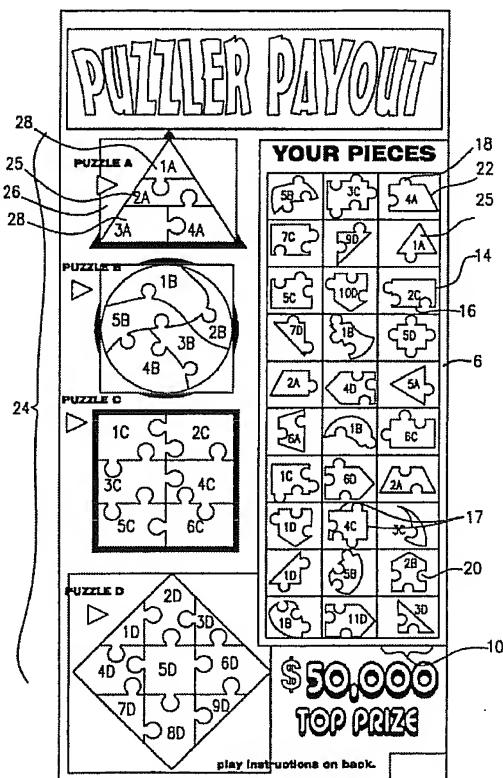


FIG. 2  
Fig. 2 of the Subject Application

With further reference to claim 1, the second play area comprises a plurality of second play regions, each containing at least two second jig-saw type puzzle pieces imprinted therein and mated to form a shape. At least two of the second play regions form different shapes comprised of different jig-saw type puzzle pieces. For example, as shown in Figure 2 above, second play area 24 (on the left-hand side of Fig. 2's

lottery ticket) includes four play regions having different shapes - Puzzle A with puzzle pieces mated to form a triangular shape, Puzzle B with differently shaped puzzle pieces than Puzzle A mated to form a circular shape, Puzzle C with a square shape, and Puzzle D with a diamond shape. The different shapes of the multiple second play regions in a second play area are described more particularly in the originally filed specification at page 6, lines 1-14.

Pollard fails to disclose all physical limitations of present claim 1. In particular, Pollard does not disclose a lottery ticket with a first play area having first jig-saw type puzzle pieces having an irregular shape and at least one first irregular shaped mating surface comprising a projection or cavity adapted to mate to a complimentary mating surface comprising a projection or cavity of at least one other first jig-saw type puzzle piece.

In contrast, Pollard discloses a substrate 10 with a first area 11 defining a caller's card and four second areas 12, 13, 14 and 14 defining respective player's cards, as shown in Fig. 1 (reproduced below). Game pieces in Pollard's bingo game are formed in a matrix of rows and columns, and the only physical characteristic associated with each game piece is a number 26 (e.g., "B03" as shown in Fig. 1). These components clearly are not puzzle pieces as defined in present claim 1 because they are merely square blocks in a grid. The square Bingo spaces of Pollard have no structural limitations defining their shape as irregular with at least one projection or cavity forming an irregular-shaped mating surface, as required by claim 1.

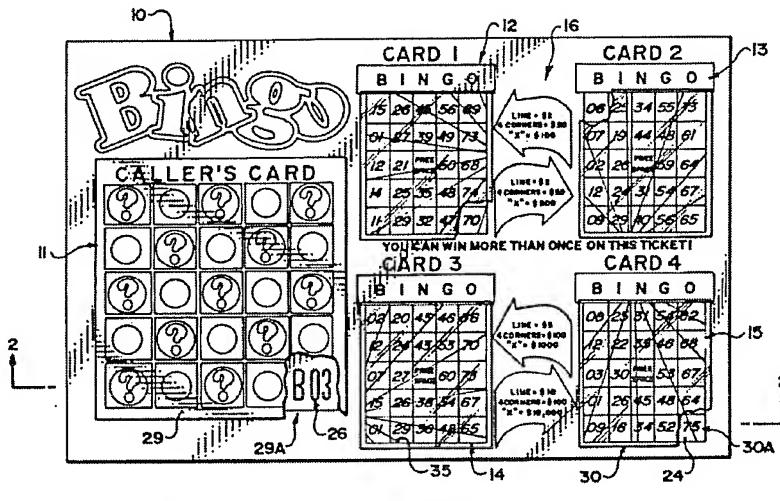


FIG. 1

Fig. 1 of U.S. Patent No. 5,193,815 (Pollard)

An additional structural limitation of claim 1's lottery ticket distinguishing it from Pollard relates to the second play regions within the requisite second play area. In claim 1, at least two of the second play regions form different shapes comprised of different jig-saw type puzzle pieces. Increased visual appeal and gaming challenge in the mating of first play area puzzle pieces to form a second play region pattern is achieved by requiring that at least two second play regions form different shapes (e.g., a triangle, circle, rectangle, diamond, etc.)

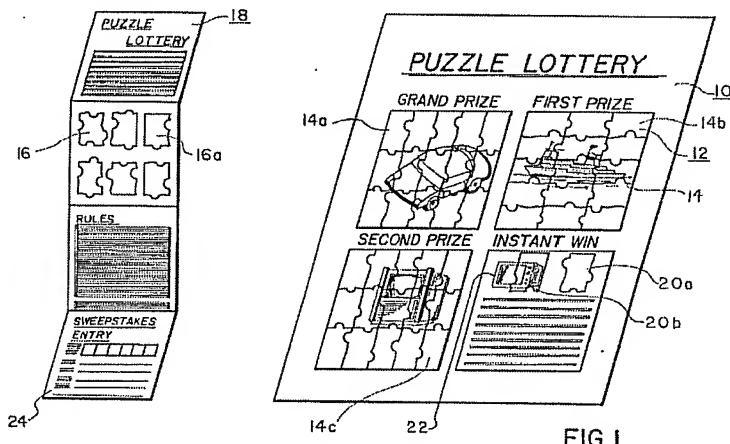
Pollard is different for two reasons. First, if the play areas 12, 13, 14 and 15 defining player's Bingo cards in Pollard are equated with second play regions, then it is apparent that each play region of Pollard has the same shape – a 5x5 matrix of squares. As such, Pollard does not have at least two second play regions with different shapes. Second, each play area 12, 13, 14 and 15 in Pollard each has the same type of game pieces – simple square blocks. As such, Pollard fails to disclose different play regions formed from differently shaped jig-saw type puzzle pieces.

Hopkins et al. fails to cure the above deficiencies of the Pollard reference. In particular, Hopkins et al., although generally disclosing jig-saw type puzzle pieces, does not provide such puzzle pieces in the structural configuration of first and second play areas and play regions as required by claim 1. In particular, Hopkins et al. fails to

disclose the requisite second play areas, at least two of which form patterns of different shapes, each pattern being comprised of differently shaped jig-saw type puzzle pieces.

If the game board 10 with different outlined positions 14 disclosed in Hopkins et al.'s Fig. 1 (reproduced below) is equated with the second play area with multiple play regions of claim 1, it is clear that such play positions 14 are all the same pattern and include the same type of puzzle pieces. In particular, col. 1, line 61 – col. 2, line 2 of Hopkins et al. specifically states that "all the jig saw puzzles use identical jig saw patterns, all the boards having identical shaped puzzle pieces in identical positions." This requirement achieves a stated object of the Hopkins et al. invention by "increase[ing] the challenge of the game" and adding a "further level of complication...to make the identity of the patterns less noticeable." As such, the different puzzle positions 14 in Hopkins et al. have identical puzzle piece positioning and patterns and do not form different patterns with each pattern being comprised of differently shaped puzzle pieces, as required by present claim 1.

FIG. 2



Figs. 1 and 2 of U.S. Patent No. 4,778,153 (Hopkins et al.)

Additional limitations of claim 1 are not met by the Hopkins et al. reference. In particular, Hopkins et al. also fails to particularly disclose: (i) first and second play areas on a single lottery ticket; (ii) first jig-saw type puzzle pieces covered by a removable scratch-off layer; and (iii) indicia on the puzzle pieces as part of a jig-saw type puzzle piece identification system.

Claim 1 is directed to a (single) lottery ticket with two play areas on the same given ticket. In contrast, Hopkins et al. discloses a system with multiple distinct components, requiring a game board 10 and a separate plurality of game cards 18 having individual removable puzzle pieces 16. Thus, the promotional game of Hopkins et al. is not played on a single lottery ticket as required by claim 1, but must be played by removing puzzle pieces from a game card and physically placing them in a superimposed relationship on a separate game board. As such, Hopkins et al. fails to disclose first and second play areas on a single ticket as set forth in claim 1.

Claim 1 also requires that the first jig-saw type puzzle pieces are covered with a removable scratch-off layer. This structural limitation of claim 1 is not disclosed in Hopkins et al., nor would it make sense to modify Hopkins et al. to include such a feature because the puzzle pieces 16 on game card 18 are supposed to be physically removed from the game card 18. If the game cards are to be removed, it would not be obvious to one of skill in the art to require an inconvenient additional step of requiring removal of a scratch-off layer before subsequent removal of the pieces. Since the Hopkins et al. puzzle pieces are to be removed and are provided with adhesive backing, it may not even be possible to cover the pieces with scratch-off material (or to subsequently remove such material) since they are likely raised off the game card to facilitate removal. A scratch-off layer would also be unobvious for purposes of hiding the puzzle pieces because the game card 18 is initially folded and glued to conceal the puzzle pieces. A scratch-off layer might only help if the puzzle pieces were visually exposed to a potential contestant. As such, the presence of a removable scratch-off layer over first jig-saw type puzzle pieces is not only absent in Hopkins et al., but it would not be obvious to one of ordinary skill in the art to include such feature.

Finally, Hopkins et al. does not include first and second indicia on respective first and second play area puzzle pieces to help indicate a match between first and second jig-saw type puzzle pieces. Instead, all puzzle pieces and patterns in Hopkins et al. are purposefully identical to increase the challenge of trying to solve the puzzles. If indicia were added to help identification, it would go against a stated principle of operation of the Hopkins et al. puzzles by taking away some of the challenge of solving the Hopkins

et al. puzzles. As such, the presence of first and second indicia is not only absent in Hopkins et al., but it would not be obvious to one of ordinary skill in the art to include such a limitation.

As described above, it is clear that several physical limitations of claim 1 are not disclosed singularly or in combination of the cited Pollard and Hopkins et al. references. In pertinent part, such references fail to disclose at least the cavities and projections defining the irregular shaped mating surfaces of the first jig-saw type puzzle pieces which are visually matched with puzzle pieces in a second play area, including multiple second play regions forming different shapes of different mated jig-saw type puzzle pieces.

It should be further appreciated that these structural limitations help define a functional relationship between the irregular shaped puzzle pieces and their irregular shaped mating surfaces that must be satisfied to "solve the puzzle" and win a prize. In particular, a projection or cavity defining each first irregular shaped mating surface must be mated with a complimentary mating surface comprising a projection or cavity of at least one other first jig-saw type puzzle piece. All puzzle pieces required for mating to form a patterned play region within the second play area are further required to win the game. Thus, there is a meaningful functional relationship between the puzzle pieces of the first and second play areas and the substrate of claim 1's lottery ticket. The puzzle pieces and mated projections/cavities in the first play area relate to the puzzle pieces in the second play area in a manner which is unique to the present invention and is not just a changing of printed indicia.

Because there is a meaningful functional relationship between the physical components of claim 1's lottery ticket and the substrate on which such ticket is printed, the *In re Gulack*<sup>1</sup> case does not prevent claim 1 from patentably distinguishing over the cited prior art. *In re Gulack* only prevents a claimed invention from distinguishing over the prior art in terms of patentability when claimed matter printed on a substrate has NO functional relationship to the substrate. Since the physical components provided as part of claim 1's lottery ticket – namely, the first and second play areas, second play regions,

<sup>1</sup> *In re Gulack*, 217 U.S.P.Q. 401 (CAFC 1983).

and irregular-shaped first and second jig-saw type puzzle pieces with respective projections and cavities mated in complementary locations – have a specific functional relationship relative to their placement and interconnection on the substrate, claim 1 is patentable over the cited references. Such a conclusion is surely in keeping with the thousands of apparatus claims that have issued over the years in the field of lottery ticket inventions – otherwise, all such claims involving a substrate with printed game components would be unpatentable.

Based on the above remarks, it is clear that Pollard and Hopkins et al. are insufficient singularly or in combination to support a prima facie case of obviousness relative to independent claim 1. Because of such deficiencies, Applicants respectfully request withdrawal of the pending rejection of claim 1 under 35 U.S.C. § 103(a).

Regarding claims 2-6, 13 and 15-16, Applicants also respectfully request allowance of such claims because they depend from otherwise allowable claim 1 (per the above distinguishing remarks) and further limit such claim. If an independent claim is nonobvious under 35 U.S.C. § 103(a), then any claim depending therefrom is nonobvious. *In re Fine*, 387 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1998), emphasis added. As such, Applicants respectfully request withdrawal of the pending obviousness rejection of claims 1-6, 13 and 15-16 citing Pollard in view of Hopkins et al.

**C. Rejection of Claims 7-9 (35 U.S.C. § 103(a)):**

Claims 7-9 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Pollard in view of Hopkins et al. and further in view of U.S. Patent No. 4,778,153 (Bachman).

Applicants respectfully submit that the deficiencies identified above relative to independent claim 1 are not cured by Bachman. Since claims 7-9 depend from otherwise allowable claim 1 and further limit this claim, claims 7-9 should also be allowed over the combination of cited references for the reasons already identified above. If an independent claim is nonobvious under 35 U.S.C. § 103(a), then any claim depending therefrom is nonobvious. *In re Fine*, 387 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1998), emphasis added. As such, Applicants respectfully request withdrawal

of the pending obviousness rejection of claims 7-9 citing Pollard in view of Hopkins et al. and further in view of Bachman.

**D. Conclusion**

For at least the reasons set forth above, Applicants request withdrawal of the present rejections. Applicants encourage the Examiner to contact the undersigned with any questions or comments.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully submitted,  
DORITY & MANNING, P.A.

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